

REMARKS:

Claims 1-21 are pending in the application. By this amendment, claims 1-5, 7-16, 20, and 21 are amended. Applicant requests reconsideration and allowance in view of the above amendments and the following remarks.

Rejection Under 35 U.S.C. § 112

Claims 1-9 and 20 are rejected under 35 U.S.C. § 112, second paragraph. According to the Office Action, the claims are directed to a “sealing arrangement” (as per the preamble), whereas only a sealing strip is recited. To overcome this issue, and consistent with the manner in which the Examiner has already examined the claims, Applicant has amended the preamble to recite a “sealing member.” Accordingly, Applicant requests that the rejection be withdrawn.

Rejections Under 35 U.S.C. § 102

Claims 1-9 and 20 (1 and 20 being independent) are rejected under 35 U.S.C. 102(b) as anticipated by Horvath, U.S. 3,643,968. In Horvath, a spongy ring of material 34 fits within a support member 30, and positioning/hold-down tabs with holes extend from the support member 30. In essence, the Examiner apparently has construed the support member as the claim-recited sealing member and has “laid” the claim language on Horvath with that construction of Horvath in mind. Applicant requests reconsideration and withdrawal of the rejection in view of the above clarifying amendments.

In particular, the independent claims (including claim 21, which is not rejected over Horvath) are amended to clarify that the sealing strip has a solid cross-section. (Support for such amendment may be found at least in the various Figures of the application.) In Horvath, in contrast, the support member 30 – assuming, as noted above, that that is the portion of the Horvath gasket the Examiner is construing as the sealing strip – has an open, cup-shaped cross-section into which the ring of material 34 fits. Thus, the claims distinguish over Horvath in at least that regard.

Alternatively (if the Examiner's position is that the combined support member 30 and spongy material 34 in Horvath constitute the claim-recited sealing strip) or additionally, Applicant notes that the claims specifically recite that the sealing strip is made from substantially incompressible material. In Horvath, in contrast, all gaskets disclosed therein are specifically elastomeric. Thus, the claims distinguish over Horvath in at least that regard, as well.

Furthermore, Applicant notes that these distinguishing features of the claimed invention are significant. In particular, as explained, for example, in the Background of the Invention and Summary of the Invention sections of the application, incompressibility – which the solid cross-section fosters – prevents variation in pressure along the sealing joint and, hence, provides for better, more uniform sealing. The gasket configuration in Horvath, in contrast, is clearly designed to be compressible and will not provide the uniform sealing configuration Applicant's invention provides. Accordingly, not only does Horvath not anticipate the claimed invention, but Horvath does not render it obvious, either.

Claims 1, 2, 4-11, and 13-21 are rejected under 35 U.S.C. § 102(e) as anticipated by Hammi, U.S. 6,761,360. In Hammi, a lip of material – the part with the two knob-shaped portions 46A and 46B – extends inwardly from the main portion of the seal, and the Examiner has construed the space between the knob-shaped portions as the claim-recited recess in the protrusion. Applicant requests reconsideration and withdrawal of the rejection in view of the above clarifying amendments.

In particular, the independent claims are amended to specify a plurality of discrete protrusions. (Support for such amendment may be found at least in the various Figures of the application.) In Hammi, in contrast, there is just a single, continuous protrusion extending along the entire length of the gasket. Thus, the claims distinguish over Hammi in at least that regard.

Furthermore, as with respect to the distinction over Horvath, Applicant notes that this distinction is significant. In particular, the claimed configuration maintains seal integrity by providing a sealing member that generally retains its shape, with a plurality of discrete protrusions being provided to secure the strip in a sealing groove. With the Hammi configuration, in contrast, pinching the single, continuous protrusion would clearly cause it to wrinkle distort, and that would be anathema to the sealing performance Applicant's configuration

achieves. Thus, not only does Hammi not anticipate the claimed invention, but Hammi does not render it obvious, either.

Rejection Under 35 U.S.C. § 103

Claims 10-19 and 21 are rejected under 35 U.S.C. 103(a) as obvious based on Sumitomo in view of Nathan, U.S. 2,615,741. According to the Office Action, Sumitomo shows all features of the claimed invention except for the protrusions having lead-throughs. However, according to the Office Action, Nathan shows hollow protrusions extending from a sealing strip “to provide self-energizing protrusions.” Therefore, according to the Office Action, it would have been obvious to modify Sumitomo to have hollow protrusions as (allegedly) shown in Nathan because “to provide solid protrusion or hollow protrusion is considered to be art equivalent and furthermore to having hollow protrusion make [sic] the protrusions self energizing[.]” Applicant firmly refutes this assertion.

In Sumitomo, retention of the sealing strip in the channel 16 relies on secure engagement of the T-shaped protrusions 22 in the opening 17, 18, 19 located to the side of the channel 16. Making those protrusions 22 hollow (i.e., with lead-throughs) as the Examiner posits would significantly reduce the retention capability of the protrusions 22 and allow the sealing strip to pull out of the channel 22 far more easily, thus defeating the purpose of the Sumitomo configuration. Accordingly, Applicant submits that one having skill in the art would not have been motivated to modify Sumitomo as the Examiner has suggested, the Examiner’s assertion of art-equivalence notwithstanding.

Moreover, Applicant submits that the proffered combination is clearly driven by nothing more than hindsight. In the recent case of *KSR*, broad concepts or building-block components were combined and each used in the same manner as they had been used individually (adjustable gas pedal; rotational sensor; pivot axis; and electronic throttle control). In ruling that the subject combination of features would have been obvious, the Supreme Court repeatedly referred to predictable modifications and results. Where it was large-scale, wholesale concepts that were combined, the predictability (i.e., obviousness) of the combination was manifest. Here, in sharp contrast, the Examiner has focused myopically on a minor feature or detail in the secondary reference (in contradistinction to the whole broad concept of the reference) and asserted that it

would have been obvious to incorporate such nuance into the primary reference. Of all the features present in the secondary reference, however (height, length, texture, cross-sectional shape, geometry, etc.), there is no predictable reason why, but for impermissible hindsight, one having skill in the art would have zeroed in on the hollow nature of the protrusions in Nathan and incorporated such feature into Sumitomo. Accordingly, Applicant traverses the rejection and requests that it be withdrawn.

In view of the foregoing, Applicant submits that all claims are in condition for allowance, and timely Notice to that effect is respectfully requested.

The undersigned representative requests any extension of time that may be deemed necessary to further the prosecution of this application.

The undersigned representative authorizes the Commissioner to charge any additional fees under 37 C.F.R. 1.16 or 1.17 that may be required, or credit any overpayment, to Deposit Account No. 14-1437, referencing Attorney Docket No.: 6730.054.PCUS00.

In order to facilitate the resolution of any issues or questions presented by this paper, the Examiner may directly contact the undersigned by phone to further the discussion. **Moreover, should the Examiner remain of the opinion that the cited references anticipate and/or render obvious the various claims invention, Applicant requests an interview to discuss the matter in greater detail at the Examiner's earliest convenience.**

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